Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed February 13, 2009. Currently, claims 33, 35, 38-50, and 53-63 remain pending. Claims 33, 35, 38-50, and 53-63 have been rejected. Claims 33 and 49 have been amended to clarify the relationships among the elements of the respective claims. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 102

Claims 33, 35, 38, 41-50, 53, and 56-63 were rejected under 35 U.S.C. 102(e) as anticipated by Gilson et al. (U.S. Published Patent Application No. 2002/0052626), hereinafter Gilson. After careful review, Applicant must respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, *814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131).* Nowhere does Gilson appear to teach or suggest, "providing a filter longitudinally fixed on a guidewire", as recited in independent claims 33 and 48.

Instead, Gilson appears explicitly to teach that an important advantage of the invention is that because the filter is not attached/fixed to the guidewire in each of paragraphs [0146] and paragraphs [0147], the "the guidewire which is first advanced through the vasculature has a lower profile" and "if the deployed filter is mis-sized with respect to the region of the treatment site it is free to be carried distally by blood flow to a narrow section of the vasculature at which the filter effectively achieves apposition with the vessel wall". Although the Examiner has asserted that the guide wire of Gilson is "fixed to the filter when being loaded into loading tool", it appears apparent that the pulling device (150) merely urges the filter into the loading device/pod assembly through transient contact between distal stop (72) and distal end (49) of sleeve (43). Operation of the filter as it is deployed within the body as taught by Gilson, as discussed above, appears to require that pushing the guide wire (71) will disengage distal stop (72) from

distal end (49). Readily reversible contact between a stop attached to the guide wire and the filter is not sufficient to anticipate a filter longitudinally fixed to the guide wire especially when Gilson explicitly states that the filter importantly is not fixed or attached to the guidewire. Further, the dictionary definition of "fixed": "adjective: 1. firmly placed or attached; not movable" found, among other sources, in Webster's New World College Dictionary, 4th Ed. is incompatible with the Examiner's interpretation of the term as may be seen in Figs. 59 and 60 of Gilson in which the guidewire (71) appears to move relative to filter (40).

Further, Gilson does not appear to disclose "coupling the loading tool to the distal end of the delivery sheath, wherein the step of coupling the loading tool to the delivery sheath is accomplished by fitting the loading tool over the exterior surface of the delivery sheath". Instead, as will be seen in Figs. 59-62, Gilson appears to disclose that loading device (7) fits within the distal end of pod (13) rather than over the distal end of the exterior surface of the delivery sheath. In this regard, it should be noted that Gilson identifies element (7) of Figs. 59-62 as the loading device and pod (13) as the sheath at the distal end of catheter (2) which is the reverse of the correspondence proposed by the Examiner in the current Office action. If, as proposed by the Examiner, element (13) is the loading device of Gilson and element (7) corresponds to the delivery sheath of claim 1, Gilson would appear to disclose that the proximal end of the delivery sheath (7) fits within the distal end of the loading device (13) rather than the claimed arrangement in which the distal end of the delivery sheath fits within the proximal end of the loading device.

Further still, the identification of elements proposed by the Examiner would appear to reverse the last two steps of claim 1, by causing the filter to move into the lumen of the delivery sheath (7) where it would shift to a collapsed configuration before being pulled within the lumen of the loading device (13). It should be noted that this would also suggest that Fig. 62 of Gilson illustrates a filter disposed within loading device (13) following disassociation of delivery sheath (7).

Applicant suspects that the Examiner has inadvertently reversed the role of the elements identified by reference numerals 7 and 13, however, this does not alter the observations that Gilson specifically discloses that importantly the filter of his invention

is not fixed to the guidewire and discloses that the loading device fits within the lumen of his delivery sheath rather than over the distal end thereof, thereby presumably requiring an undesirably larger diameter delivery sheath and resulting in a more loosely packed filter within the delivery sheath following withdrawal of the loading device than would result from the operation of pending claims 33 and 48. With regard to the relative interior and exterior location of the loading device relative to the delivery sheath, it should be noted that it is established that the identification of similar parts in a different arrangement is not sufficient to constitute anticipation.

For at least these reasons, Gilson does not appear to disclose *each and every element as set forth in the claims* and Applicant respectfully requests that the rejections of independent claims 33 and 49 be with drawn.

Additionally, for similar reasons as well as others, claims 35, 38-48, 50, and 53-63, which depend from claims 1 and 49 respectively, and include significant additional limitations, are believed to be not anticipated by Gilson and Applicants respectfully request that the rejections be withdrawn

Claim Rejections – 35 USC § 103

Claims 39, 40, 54, and 55 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gilson. After careful review, Applicant must respectfully traverse this rejection.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03). As discussed previously, nowhere does Gilson appear to disclose "providing a filter longitudinally fixed on a guidewire", as recited in independent claims 33 and 48. Instead, Gilson explicitly teaches away from such a configuration. Furthermore, nowhere does Gilson disclose, "coupling the loading tool to the distal end of the delivery sheath, wherein the step of coupling the loading tool to the delivery sheath is accomplished by fitting the loading tool over the exterior surface of the delivery sheath", as discussed above. Again, the teaching of Gilson appears to teach away from a loading tool which is fit over the distal end of a delivery sheath. Therefore, Gilson does

not appear to teach all the limitations of claims 33 and 49, as is required to establish a *prima facie* case of obviousness.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

Consequently, claims 39, 40, 54, and 55, which depend from nonobvious independent claims 33 and 49 respectively, are also nonobvious and Applicant respectfully requests that the rejections be withdrawn.

In the Response to Arguments, the Examiner has asserted that "under the broadest reasonable interpretation, the loading device 7 can be considered a delivery sheath". Applicant respectfully disagrees. Loading device (7) appears to act only as a receiving portion of the pod/loading device assembly found in Figures 59-61 of Gilson. It does not appear to take on a delivery role at any point during the loading process or the subsequent use of the filter delivery system. The filter (40) appears to be received within the loading device (7) which is positioned within pod (13) (Seen most clearly in Figs.63 and 64.) at the time when the filter (40) enters the pod (13). Loading device (7) then appears to be disassociated from the pod/loading device assembly by distal removal while the filter is retained within the pod (13) by pulling device (150) through temporary contact between distal stop (72) and the distal end (49) of freely-translating sleeve (43). Thus the loading device appears only to receive the filter which subsequently remains stationary within the pod and the loading device never provides a delivery function. As will be seen in Fig. 61 and 62, the filter is fully positioned within the pod when the loading device is disassociated and is not present when the filter is subsequently delivered.

The Examiner then returns to a discussion the manner in which the various elements of Gilson have been characterized in the recent Office Actions and Responses thereto. In the Office Action mailed April 10, 2007, the Examiner incorrectly identified element 43 (a sleeve, commonly referred to as a spinner tube in the art, which is a part of filter 40) of the Figures of Gilson as corresponding to the delivery sheath. This error was brought to the Examiner's attention in the Response of July 9, 2007 and acknowledged in the Office Action of July 24, 2008. In rewriting the rejection over Gilson in the Office

Action of July 24, 2008, the Examiner proposed a correspondence between the elements of Gilson and those of the pending claims, discussed in detail above, in which the purported delivery sheath is located between the purported loading device and the filter along the guidewire at the beginning of the loading sequence of Figs. 59-62 such that the filter must first enter the purported delivery sheath before being received in the purported loading device. In the methods of claims 33 and 49, this order is reversed and so, for at least this reason, Gilson does not anticipate the claims under §102. In attempting to raise this issue in the Response of October 22, 2008, Applicant pointed out several positional inconsistencies between the language of the claims and the Examiner's characterization of the elements of Gilson. In the Office Action mailed February 13, 2009, the Examiner appears to have substantially copied the Office Action of July 24, 2008 and so continues to repeat the apparently interchanged roles of the delivery sheath and the loading device. The only exception, identifying element 7 of Gilson as a loading device, is found in the Response to Arguments. Accordingly, the earlier Remarks have pointed out the apparent errors and have indicated that even if the reference numerals were accidentally transposed, the loading device of Gilson is positioned within his delivery sheath as opposed to fitting the loading tool over the (distal) exterior surface of the delivery sheath.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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